



February 18, 2014

VIA E-FILING

The Honorable Richard J. Andrews
United States District Court
District of Delaware
J. Caleb Boggs Federal Building
844 N. King Street, Unit 9, Room 6325
Wilmington, DE 19801-3555

**Re: InvestPic, LLC v. Algorithmics et al. (Case No. 1:10-cv-01028-RGA);
InvestPic, LLC v. SAS Institute, Inc. (Case No. 1:12-cv-00603-RGA)**

Dear Judge Andrews:

The parties provide this response to the Court's Order dated February 10, 2014, directing them to file a status letter regarding the reexamination of the patent-in-suit, U.S. Patent No. 6,349,291 ("the '291 patent").¹

There are two reexamination proceedings of the '291 patent ongoing at the U.S. Patent & Trademark Office ("PTO"): (1) *inter partes* reexamination control no. 95/001,939 ("the *inter partes* reexamination"); and (2) *ex parte* reexamination control no. 90/012,366 ("the *ex parte* reexamination").

(1) **The *inter partes* reexamination:** Claims 1-5, 8-16, 19-21 and 29-31 of the '291 patent are currently being reexamined by the PTO in the *inter partes* reexamination. The PTO declined to order an *inter partes* reexamination of claims 6-7, 17-18 and 22-28 of the '291 patent. (Claims 22-28 remain at issue in the *ex parte* reexamination, as discussed below.)

The PTO rejected original claims 1-5, 8-16, 19-21 and 29-31 of the '291 patent as unpatentable in view of prior art in a First Office Action on May 18, 2012. InvestPic responded to that Office Action on July 18, 2012, arguing that the original claims were patentable over the prior art.

The PTO issued a First Action Closing Prosecution on February 22, 2013, again rejecting original claims 1-5, 8-16, 19-21 and 29-31 of the '291 patent in view of the prior art. On March 22, 2013, in response to the First Action Closing Prosecution, InvestPic amended each of the independent

¹ This letter is submitted on behalf of Plaintiff InvestPic, LLC and Defendants International Business Machines Corporation, Algorithmics (US), Inc., SAS Institute, Inc., TIBCO Software, Inc., Misys International Banking Systems, Inc., Misys PLC, Sungard Data Systems, Inc., RiskMetrics Solutions, Inc., MSCI Inc. SS&C Technologies, Inc., and FactSet Research Systems, Inc.

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claims being reexamined in the *inter partes* reexamination (independent claims 1, 11 and 29), and argued that the amended claims were patentable over the prior art. Patent Owner InvestPic rewrote allowed/confirmed claims 6 and 17 into independent form.

The PTO finally rejected claims 1-5, 8-16, 19-21 and 29-31, as amended by InvestPic, in a Second Action Closing Prosecution on August 2, 2013. The PTO found amended claims 6 and 17 were patentable. Claim 7 depends from 6, and 18 depends from 17. Therefore, Claims 6, 7, 17 and 18 currently stand confirmed and patentable.

InvestPic submitted a response to the Second Action Closing Prosecution on August 30, 2013, and concurrently filed two petitions seeking to further amend the claims and asking the PTO to withdraw the final rejection of the claims.

As of February 12, 2014, the PTO has denied or dismissed as premature each of InvestPic's petitions seeking to further amend the claims, and the PTO has refused to withdraw the final rejection of claims 1-5, 8-16, 19-21 and 29-31.

The parties are currently awaiting the next action by the PTO in the *inter partes* reexamination, which may be another Office Action or may be a Right of Appeal Notice to the PTO Patent Trial & Appeal Board.

(2) **The *ex parte* reexamination:** Claims 22-25 of the '291 patent are currently being reexamined by the PTO in the *ex parte* reexamination. The PTO declined to order an *ex parte* reexamination of dependent claims 26-28 of the '291 patent.

The PTO rejected original claims 22-25 of the '291 patent as unpatentable in view of the prior art in a First Office Action on February 6, 2013. InvestPic responded to that Office Action on April 5, 2013 by amending each of claims 22, 24 and 25 and arguing that the amended claims were patentable in view of the prior art. InvestPic also amended dependent claim 26 to rewrite the claim in independent form and to correct what InvestPic considered to be a clerical error.

The PTO found that claims 26-28 were patentable and/or confirmed. The PTO finally rejected claims 22-25, as amended by InvestPic, in a Final Office Action dated July 3, 2013. On August 30, 2013, InvestPic submitted a response to the Final Office Action, and concurrently filed two petitions seeking to further amend the claims and asking the PTO to withdraw the final rejection of the claims.

The PTO Examiner issued an Advisory Action on September 27, 2013, denying InvestPic's request to make further claim amendments in the reexamination proceeding. The PTO also denied or dismissed as premature each of InvestPic's petitions seeking to further amend the claims, and the PTO refused to withdraw the final rejection of claims 22-25, but indicated that the amendments could be presented in a reissue application.

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On October 16, 2013, InvestPic filed a Notice of Appeal of the final rejection of claims 22-25 to the PTO Patent Trial & Appeal Board. InvestPic submitted its opening Appeal Brief on December 16, 2013, and made an additional submission in support of its Appeal Brief on January 15, 2014 to correct informalities in the Appeal Brief.

Next, the PTO Examiner will have an opportunity to submit an Examiner's Answer, after which InvestPic may submit a reply brief. Upon completion of the briefing, InvestPic's appeal of the final rejection of claims 22-25 in the *ex parte* reexamination will be taken up by a panel of three Administrative Patent Judges of the PTO Patent Trial & Appeal Board.

Respectfully submitted,

/s/ Brian E. Farnan

Brian E. Farnan

cc: Counsel of Record (via E-Filing)